

Practitioner's Docket No. KCC-1136 (KC-16,270)

SEP 11 2006 - 7 PM 4:10

US PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

☒ In re application of:

Application No.: 10,024,634

Filed: 17 December 2001

For: S. Scott FRIDERICH et al.

Group No.: 3761

Examiner: J. Stephens

☐ Patent:

BODY FLUID SEALING GASKETS FOR PERSONAL CARE PRODUCTS
Issued:

NOTE: Insert name(s) of inventor(s) and title also for patent. Where request is with respect to a maintenance fee payment also insert application number and filing date and add Box M. Fee to address.

Mail Stop 16

Director of the U.S. Patent and Trademark Office
P.O. Box 1450, Alexandria, VA 22313-1450

**REQUEST FOR REFUND
(IMPROPER CHARGE OF DEPOSIT ACCOUNT)**

NOTE: 37 C.F.R. § 1.26(b) "Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable."

I. REFUND REQUEST

This is a request for a refund, with respect to the charge to Deposit Account 19-3550 shown on the statement dated December 2006, for the above-identified

☒ application.

☐ patent.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on 2 March 2006.

2 Mar 06
Date

Signature

Roland W. Morris

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(check the following, if desired, and supply copy of statement)

- ☒ A copy of the monthly statement, in which the error referred to occurs, accompanies this request.

II. FEES CHARGED FOR WHICH REFUND REQUESTED

**AMOUNT OF
REFUND
REQUESTED**

- ☐ Filing fee
☐ Surcharge for filing the basic filing fee on a date later than the filing date of the application
(37 C.F.R. § 1.16(e))

and/or

- ☐ Surcharge for filing the oath or declaration on a date later than the filing date of the application
(37 C.F.R. § 1.16(e))
☒ Extension of term
 ☐ first month
 ☒ second month
 ☐ third month
 ☐ fourth month
 ☐ fifth month
☐ Excess claims
☐ Issue fee
☐ Petition fee
☐ Patent maintenance fee
 ☐ first maintenance fee
 ☐ second maintenance fee
 ☐ third maintenance fee
☐ Patent maintenance fee surcharge
☐ Other _____

\$330.00

TOTAL REFUND REQUESTED

\$330.00

III. EXPLANATION OF WHY CONTESTED CHARGE IS IN ERROR

On 21 November 2005, Applicants filed a Pre-Appeal Brief Request for Review, a Notice of Appeal and a Petition for Extension of Time for Filing of Response Under Rule 1.136(a), including a check for \$120.00 (check #19644) to cover the one-month extension of time fee, all by Certificate of Mailing. These documents were filed in response to an Advisory Action, dated 21 October 2005. The deadline for submission of the above-referenced documents, including the one-month extension, was 21 November 2005, which fell inside the statutory period. A copy of the Pre-Appeal Brief Request for Review, the Notice of Appeal, the Petition for Extension of Time and the return receipt postcard stamped by the mailroom of the U.S. Patent and Trademark Office are enclosed.

On 05 December 2005, our Deposit Account #19-3550 was charged \$330.00 by the U.S. Patent and Trademark Office under fee code 1252 (Extension for response within second month), for the subject U.S. Patent Application. A copy of the December 2005 Deposit Account Statement is enclosed. Applicants believe that the charge was in error and request a refund to our Deposit Account #19-3550 in the amount of \$330.00

IV. MANNER OF REFUND

Please make refund by

- ☒ crediting Account No. 19-3550
☐ crediting credit card as shown on the attached credit card information authorization form PTO-2038.

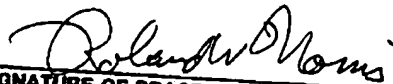
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- ☐ refunding payment.

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Tel. No.: (847) 490-1400

Customer No.: 35844


SIGNATURE OF PRACTITIONER

Roland W. Norris / Pauley Petersen & Erickson
(type or print name of practitioner)

2800 W Higgins Rd Suite 365
P.O. Address

Hoffman Estates, IL 60195

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Docket No. KCC-16270

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: S. Scott FRIDERICH et al.

Serial No.: 10/024,634

Filing Date: 17 December 2001

Title: BODY FLUID SEALING GASKETS FOR
PERSONAL CARE PRODUCTS

Customer No.: 35844

Group No.: 3761

Examiner: J. Stephens

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets, of which there are not more than five.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450 on

21 NOVEMBER 2005

21 NOV 05
Date

Rolando Morris
Signature

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Serial No. 10/024,634

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Docket No. KCC-16270

REMARKS

Applicants request that the panel review the legal and factual insufficiencies of the following rejections contained in the final Office Action of 29 June 2005, as set forth in the final Office Action thereof.

Claim Rejections -35 USC § 112

Per paragraph 5, page 5 of the final Office Action, Claims 1, 2, 4-6, 8-10, 14-19 and 21-25 are rejected under 35 USC § 112, first paragraph, as containing subject matter not sufficiently described in the specification, owing to: "The test procedures for determining a Young's modulus and a modulus of elasticity as recited in claims 1, 8, and 9 are not enabled by the disclosure. The test characteristics cited in the application do not include the test procedures."

The factual basis of this rejection is clearly in error.

Applicants further contend the Examiner has not provided sufficient factual findings with respect to the ordinary level of skill in the art to support a *prima facie* case for this rejection. Applicants further contend that no reasonable findings with respect to the ordinary level of skill in the art could support a *prima facie* case for this rejection sufficient to overcome the strong presumption that the application is enabling to a person having ordinary skill in the art.

Applicants refer the panel to their discussion of the legal and factual sufficiency of the test procedures complained of in this rejection as contained in Applicants' Request for Reconsideration filed 29 August 2005, at pages 2-3 (1st five paragraphs under the heading "Claim Rejections -35 USC § 112") and the corresponding arguments at Applicants' Amendment C filed 03 November 2004 at pages 8-9 (under the heading "Allowable Subject Matter") and pages 10-11 (1st two paragraphs under the heading "Claim Rejections -35 USC § 112"). Applicants again assert that those of ordinary skill would understand with reasonable certainty how to practice the present invention.

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Serial No. 10/024,634

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Docket No. KCC-16270

The panel is further requested, in fairness to the Applicants, to review the irregularity of the examination of the present invention wherein the Office's response of 24 March 2005 to Applicants' Amendment C made no further mention of the §112 rejections but was merely a restriction requirement. After Applicants' election per their Amendment D filed 13 April 2005, the §112 rejections were resurrected in the final Office Action of 29 June 2005.

Per paragraph 6, page 5 of the final Office Action, Claims 1, 2, 4-6, 8-10, 14-19 and 21-25 are rejected under 35 USC § 112, first paragraph: "because the specification, while being enabling for the embodiments taught in examples 1 and 2 on page 26 of the disclosure, does not: "reasonably provide enablement for other types of materials or combinations of construction." and further: "fails to teach one of ordinary skill in the art the exact film needed or the exact process for forming the nonwoven web to provide the claimed test results. [emphasis added]"

Both the legal basis and the factual basis of this rejection are clearly in error. The Office has imposed an undue burden upon the Applicants to inform the public of every material meeting the claim language.

Applicants refer the panel to their discussion of the legal and factual sufficiency of the specification in refuting this rejection at Applicants' Request for Reconsideration filed 29 August 2005, at page 3, 3rd paragraph, to page 5; and the corresponding arguments at Applicants' Amendment C filed 03 November 2004 at page 11, 1st paragraph, to page 13, 1st paragraph. Applicants again assert that those of ordinary skill would understand with reasonable certainty how to practice the present invention.

The structure and function of the present invention are adequately explained to enable a person having ordinary skill in the present art to make and use the claimed invention(s). The structure to achieve the different Young's Modulus in different axes, and the functional benefits from such structure, are all adequately explained in the specification. It is long settled law that the specification need not teach every conceivable embodiment encompassed by the claims. It is further well settled that

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Applicants are not required to provide an exact manufacturing specification of the type apparently being required by the Examiner in the present instance. In short, the Examiner seeks to impose extra-legal requirements upon the present application which cannot be allowed to stand.

Claim Rejections -35 USC §103

In general, the Examiner has attempted to force the Applicants into the untenable position of having to prove a negative with respect to each lack of teaching of the prior art. Applicants believe that in so far as possible under this stricture, they have provided sufficient argument that a *prima facie* case has not been made by the Office. Further, when viewed as a whole, and without benefit of hindsight, the patentability and contribution to the art of the present invention are evident.

Per paragraph 9, page 6 of the final Office Action, Claims 1, 2, 4 and 8 stand rejected as obvious over McCormack, US Patent 5,855,999 (hereinafter "McCormack").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Any suggestion that McCormack makes the presently claimed invention obvious, merely through the use of similar starting materials at some generic level, would require impermissible hindsight to achieve the present invention. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration at page 6, 3rd and 4th paragraphs; Amendment C at pages 13-14; and Amendment A, filed 12 January 2004, at pages 8-10.

Per paragraph 10, page 8 of the final Office Action, Claims 1, 6, 9, 10, 15, 16 and 25 stand rejected as obvious over Buell (US Patent 5,085,654 hereinafter "Buell").

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The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration page 7, 2nd paragraph; Amendment C page 14, last paragraph; and Amendment A filed 12 January 2004, pages 8-10.

Per paragraph 11, page 11 of the final Office Action, Claim 5 is rejected as obvious over McCormack in view of Morman, US Patent 5,226,992 (hereinafter "Morman").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration at page 7, last two paragraphs; Amendment C at page 15, 1st paragraph; and Amendment A at page 10, last paragraph.

Per paragraph 12, page 12 of the final Office Action, Claims 9, 11-12, 14, and 17-24 are rejected as obvious over McCormack in view of Sauer (US Patent 5,938,652, hereinafter "Sauer").

The factual basis and legal conclusions of this rejection are clearly in error. Applicants contend that the Examiner has not provided sufficient findings drawn from the art itself to support a *prima facie* case for this rejection. Applicants refer the panel to their discussions of the insufficiency of this rejection as contained in Applicants' Request for Reconsideration at page 8, 1st paragraph; Amendment C at page 16, 1st paragraph; and Amendment A at page 11, last paragraph.

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Serial No. 10/024,634

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Docket No. KCC-16270

Conclusion

Applicants request that the panel, upon review and understanding of the clear errors and insufficiencies of the final Office Action of 29 June 2005, find for the Applicants concerning each of the above rejections.

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris
Registration No. 32,799

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60195
TEL (847) 490-1400
FAX (847) 490-1403

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NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket Number (Optional)

KCC-16270

Customer No.: 35844

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21 November 2005

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Roland W. Norris

Typed or printed name

Roland W. Norris

In re Application of

S. Scott FRIDERICH et al.

Application Number

10/024,634

Filed

17 December 2001

For

BODY FLUID SEALING GASKETS FOR
PERSONAL CARE PRODUCTS

Group Art Unit

3761

Examiner

J. Stephens

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b))

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:

\$ 500.00

☒ A check in the amount of the fee is enclosed.

\$

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Commissioner is hereby authorized to charge any deficiencies in fees which may be required, or credit any overpayment to Deposit Account No. 19-3550. I have enclosed a duplicate copy of this sheet.

☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) and a check in the amount of \$120.00 to cover the extension of time fee is also enclosed

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I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR. Statement under 37 CFR 3.73 (b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

☐ attorney or agent acting under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a).

Roland W. Norris

Signature

Roland W. Norris

Typed or printed name

21 November 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple form if more than one signature is required, see below*.

☐ *Total of forms are submitted.

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|---------------|--|-----------------------|
| Applicants: | S. Scott FRIDERICH Jay Sheldon SHULTZ | |
| Serial No.: | 10/024,634 | Group No.: 3761 |
| Filing Date: | 17 December 2001 | Examiner: J. Stephens |
| Title: | BODY FLUID SEALING GASKETS FOR PERSONAL CARE PRODUCTS | |
| Customer No.: | 35844 | |

PETITION FOR EXTENSION OF TIME FOR FILING
OF RESPONSE UNDER RULE 1.136(a)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is filed with the Notice of Appeal in response to the Advisory Action mailed 21 October 2005. The time period for submission of this Notice of Appeal was set to expire 21 October 2005.

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21 November 2005

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Date
KCC-1136

Rolando Morris
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P.O. Box 1450, Alexandria, VA 22313-1450

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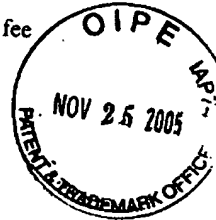
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- Pre-Appeal Brief Request for Review (6 pages)
- Petition for Extension of Time for Filing of Response Under Rule 1.136(a) (2 pages), in duplicate
- A check in the amount of \$500.00 to cover Notice of Appeal fee
- A check in the amount of \$120.00 to cover the Extension of Time fee

All by Certificate of Mailing dated 21 November 2005.

Applicants: S. Scott FRIDERICH et al.
Serial No.: 10/024,634
Filing Date: 17 December 2001
Title: BODY FLUID SEALING GASKETS FOR
PERSONAL CARE PRODUCTS
Customer No.: 35844

KCC-1136 (KCC-16270)

Roland W. Norris



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| 12/01 | 2 | 6398676 | NA-125-B-DIV2 | 2551 | \$450.00 | \$7,261.50 |
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| 12/02 | 5 | 10622752 | 32,064/KC-18,125.6 | 1202 | \$100.00 | \$6,011.50 |
| 12/05 | 2 | 10024634 | KCC-16,270 | 1252 | \$330.00 | \$5,681.50 |
| 12/05 | 116 | 75275356 | VO-8113 | 8521 | \$40.00 | \$5,641.50 |
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| 12/06 | 200 | 76348028 | VO-8186 | 7003 | \$100.00 | \$5,041.50 |
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| 12/12 | 38 | E-REPLENISHMENT | | 9203 | -\$5,000.00 | \$8,166.50 |
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| 12/29 | 314 | 6413595 | BBS-7-DIV | 2551 | \$450.00 | \$8,366.50 |
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